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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/634,916	08/09/2000	Frank Simon	032693-043	6828

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EXAMINER

KARMIS, STEFANOS

ART UNIT	PAPER NUMBER
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3624

DATE MAILED: 06/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/634,916

Applicant(s)

SIMON ET AL.

Examiner

Stefano Karmis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10 April 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 21-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 21-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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### **DETAILED ACTION**

1. This communication is in response to Applicant's amendment filed on April 10, 2003.

The rejections are as stated below.

#### ***Status of Claims***

2. Claims 1-20 have been cancelled. Claims 21-34 have been added. Therefore, claims 21-34 are under prosecution in this application.

#### ***Summary of this Office Action***

3. Applicants' arguments filed on April 10, 2003 have been fully considered, and discussed in the next section below or within the following rejection are not deemed to be persuasive. Therefore, claims 21-34 are rejected as being unpatentable over the art cited below, and Applicants' request for allowance is respectfully denied.

#### ***Response to Applicants' Amendment***

4. Applicant has cancelled claims 1-20 and therefore any arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection. The remaining traversals are discussed below in the Double Patenting Rejection and 103 Rejection.

*Double Patenting*

2. 35 U.S.C. § 101 reads as follows:

"Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title".

3. The following non-statutory double patenting rejection is based on a judicially created doctrine grounded in the public policy (a policy reflected in the statute) so as to prevent the unjustified or improper time wise extension of the right to exclude granted by a patent. In re Sarett, 327 F.2d 1005, 140 USPQ 474 (CCPA 1964); In re Schneller, 397 F.2d 350, 158 USPQ 210 (CCPA 1968); In re White, 405 F.2d 904, 160 USPQ 644 (CCPA 1969); In re Thorington, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); In re Van Ornam, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); In re Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 985); and In re Goodman, 29 USPQ 2d 2010 (Fed. Cir. 1993).

4. Claims 21-34 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 2 of U.S. Patent No. 6,195,648 Simon et al. (hereinafter Simon). Although the conflicting claims are not identical, they are not patentably distinct from each other because they recite means or steps that are substantially the same and that would have been obvious to one of ordinary skill in the art.

In reference to claim 21 of the instant application, Simon recites a method of disabling a motor vehicle in response to payments being made (column 10, lines 9-11). A code is received via a keypad, and the received code is compared against a reference code. A disabling system

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that supports causing ignition in an engine of the vehicle, if prior to payment deadline there is no agreement between the code received via the keypad and the reference code, wherein the system includes only components not dedicated to directly causing a spark to initiate combustion (column 10, lines 15-30).

The limitation of a payment interval in the instant application instead of a payment due deadline in the '648 application does not render the claim distinct. Official Notice is taken that it would have been obvious to anyone of ordinary skill in the art that payment intervals act in the same manner as payment deadline because they both specify a time limit for payment to be received.

Claim 22 and 23, Simon discloses a host computing apparatus connected to a client computer apparatus. The client computer apparatus possesses a database that stores a plurality of payment due deadlines data elements (column 8, lines 5-12).

Claim 24, a plurality of payments due deadlines are computed based on parameters with payment intervals (column 2, lines 32-55).

Claim 25, receiving another code via the keypad and comparing the another code with another reference code (column 10, lines 19-21). Disabling a system that supports causing ignition in an engine of the vehicle, if prior to payment deadline there is no agreement between the codes received via the keypad and the reference code, wherein the system includes only

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components not dedicated to directly causing a spark to initiate combustion (column 10, lines 22-30).

In reference to claim 26 of the instant application, Simon recites a method of disabling a motor vehicle in response to the matching of reference codes, stored in memory (column 2, lines 40-55). A code is received via a keypad, and the received code is compared against a reference code. A disabling system that supports causing ignition in an engine of the vehicle, if prior to payment deadline there is no agreement between the code received via the keypad and the reference code, wherein the system includes only components not dedicated to directly causing a spark to initiate combustion (column 10, lines 15-30).

Claim 27 and 28, Simon discloses a host computing apparatus connected to a client computer apparatus. The client computer apparatus possesses a database that stores a plurality of payment due deadlines data elements (column 8, lines 5-12).

Claim 29, a plurality of payments due deadlines are computed based on parameters with payment intervals (column 2, lines 32-55).

Claim 30, receiving another code via the keypad and comparing the another code with another reference code (column 10, lines 19-21). Disabling a system that supports causing ignition in an engine of the vehicle, if prior to payment deadline there is no agreement between the codes received via the keypad and the reference code, wherein the system includes only

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components not dedicated to directly causing a spark to initiate combustion (column 10, lines 22-30).

In reference to claim 31 of the instant application, Simon recites an apparatus for disabling a motor vehicle in response to payments being made (column 10, lines 9-11). A code is received via a keypad, and the received code is compared against a reference code. A disabling system that supports causing ignition in an engine of the vehicle, if prior to payment deadline there is no agreement between the code received via the keypad and the reference code, wherein the system includes only components not dedicated to directly causing a spark to initiate combustion (column 10, lines 15-30).

The limitation of a payment interval in the instant application instead of a payment due deadline in the '648 application does not render the claim distinct. Official Notice is taken that it would have been obvious to anyone of ordinary skill in the art that payment intervals act in the same manner as payment deadline because they both specify a time limit for payment to be received.

Claim 32 and 33, Simon discloses a host computing apparatus connected to a client computer apparatus. The client computer apparatus possesses a database that stores a plurality of payment due deadlines data elements (column 8, lines 5-12).

Claim 34, a plurality of payments due deadlines are computed based on parameters with payment intervals (column 2, lines 32-55).

5. A timely filed terminal disclaimer in compliance with 37 CFR 1.321(b) would overcome an actual or provisional rejection on a non-statutory double patenting ground provided the conflicting patent is shown to be commonly owned with this application. See 37 CFR 1.78(d).

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. Claims 21-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pagliaroli et al. (hereinafter Pagliaroli) U.S. Patent 5,276,728 in view of Forbes U.S. Patent 6,025,774.



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Regarding claim 21, Pagliaroli teaches a system to disable a vehicle, where a code is received via a telephone keypad. The code is then referenced against a disabling code and if the code criteria is met, the vehicle is disabled by sending a signal to the ignition and the starter.

Pagliaroli fails to teach that disabling the vehicle based on a payment interval. Forbes teaches a method for retrieving vehicular collateral that disables a vehicle based on delinquent payments on loans or leases (column 1, lines 10-47).

Therefore it would have been obvious at the time of the Applicant's invention to modify the teaching of Pagliaroli to include disabling the vehicle based on payments because it is commonly practiced to disable equipment for such delinquencies in paying telephone bills or electric bills.

Pagliaroli fails to specifically teach that the disabling system is only for components not dedicated to causing a spark needed to initiate combustion. Official Notice is taken that a spark in the ignition is well known in the art when starting a motor vehicle. Therefore it would have been obvious at the time of the Applicant's invention to modify the teachings of Pagliaroli to specify that they system is only for components not dedicated to causing a spark to initiate combustion.

Claims 22 and 23, Pagliaroli teaches a host computing apparatus connected to a client computer apparatus (Figure 1). The computing apparatus consists of a programmable memory for storing codes (Figure 2).

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Claim 24, Pagliaroli fails to teach computing a plurality of payment due deadlines based on the payment interval. Official Notice is taken computing payment deadlines is old and well known in the art. Therefore it would have been obvious at the time of the applicant's invention to modify the teachings of Pagliaroli to include computing payment deadlines based on payment intervals because it is common practice in billing procedures.

Claim 25, Pagliaroli teaches a system to disable a vehicle, where another code is received via a telephone keypad. The code is then referenced against a disabling code and based on code criteria, the vehicle is disabled by sending a signal to the ignition and the starter.

Regarding claim 26, Pagliaroli teaches a system to disable a vehicle based from codes stored within a memory, where a code is received via a telephone keypad. The code is then referenced against a disabling code and if the code criteria is met, the vehicle is disabled by sending a signal to the ignition and the starter.

Pagliaroli fails to specifically teach that the disabling system is only for components not dedicated to causing a spark needed to initiate combustion. Official Notice is taken that a spark in the ignition is well known in the art when starting a motor vehicle. Therefore it would have been obvious at the time of the Applicant's invention to modify the teachings of Pagliaroli to specify that they system is only for components not dedicated to causing a spark to initiate combustion.

Claims 27 and 28, Pagliaroli teaches a host computing apparatus connected to a client computer apparatus (Figure 1). The computing apparatus consists of a programmable memory for storing codes (Figure 2).

Claim 29, Pagliaroli fails to teach computing a plurality of payment due deadlines based on the payment interval. Official Notice is taken computing payment deadlines is old and well known in the art. Therefore it would have been obvious at the time of the applicant's invention to modify the teachings of Pagliaroli to include computing payment deadlines based on payment intervals because it is common practice in billing procedures.

Claim 30, Pagliaroli teaches a system to disable a vehicle, where another code is received via a telephone keypad. The code is then referenced against a disabling code and based on code criteria, the vehicle is disabled by sending a signal to the ignition and the starter.

Regarding claim 31, Pagliaroli teaches an apparatus to disable a vehicle, where a code is received via a telephone keypad. The code is then referenced against a disabling code and if the code criteria is met, the vehicle is disabled by sending a signal to the ignition and the starter.

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Pagliaroli fails to teach that disabling the vehicle based on a payment interval. Forbes teaches a method for retrieving vehicular collateral that disables a vehicle based on delinquent payments on loans or leases (column 1, lines 10-47).

Therefore it would have been obvious at the time of the Applicant's invention to modify the teaching of Pagliaroli to include disabling the vehicle based on payments because it is commonly practiced to disable equipment for such delinquencies in paying telephone bills or electric bills.

Pagliaroli fails to specifically teach that the disabling system is only for components not dedicated to causing a spark needed to initiate combustion. Official Notice is taken that a spark in the ignition is well known in the art when starting a motor vehicle. Therefore it would have been obvious at the time of the Applicant's invention to modify the teachings of Pagliaroli to specify that the system is only for components not dedicated to causing a spark to initiate combustion.

Claims 32 and 33, Pagliaroli teaches a host computing apparatus connected to a client computer apparatus (Figure 1). The computing apparatus consists of a programmable memory for storing codes (Figure 2).

Claim 34, Pagliaroli fails to teach computing a plurality of payment due deadlines based on the payment interval. Official Notice is taken computing payment deadlines is old and well known in the art. Therefore it would have been obvious at the time of the applicant's

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invention to modify the teachings of Pagliaroli to include computing payment deadlines based on payment intervals because it is common practice in billing procedures.

*Conclusion*

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

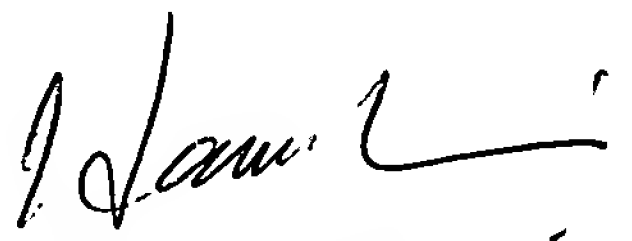
11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stefano Karmis whose telephone number is (703) 305-8130. The examiner can normally be reached Monday-Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached at (703) 308-1065.

The fax number for Formal or Official faxes and Draft or Informal faxes to Technology Center 3600 or this Art Unit is (703) 305-7687 or 7658.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113.

Respectfully Submitted,  
Stefano Karmis  
Art Unit 3624  
January 15, 2003

  
**HANI M. KAZIMI**  
**PRIMARY EXAMINER**